

Application No. 10/604,297  
Technology Center 3731  
Amendment dated October 13, 2006  
Reply to Office Action dated April 13, 2006

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### REMARKS

In the Office Action, the Examiner reviewed claims 1-20 of the above-identified US Patent Application, with the result that claims 1, 2, and 5-20 were rejected under the judicially-created doctrine of obviousness-type double patenting, and all of the claims were rejected under 35 USC §102.

In the present response, Applicant has amended the claims as set forth above. More particularly:

Independent claim 1 has been amended to incorporate the limitations of its dependent claims 3, 5, 6, and 7.

Dependent claim 4 has been amended to depend from claim 1 instead of claim 3 in view of the incorporation of the limitations of claim 3 into its parent claim 1.

In view of the incorporation of their limitations into their parent claim 1, dependent claims 5, 6, and 7 have been amended to recite limitations found in paragraph [0015] of the specification, which discloses:

Each surface 22 and 24 preferably has a constant radius of curvature, and the thicknesses of the legs 14 in the direction of a radial of the curvature are substantially constant. The lateral surfaces of the legs 14 are contiguous with the surfaces 22 and 24, and can be of any suitable shape, e.g., rounded, flat such as the radials of the curvatures of the surfaces 22 and 24, etc. (Emphasis added.)

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Independent claim 11 has been amended to incorporate the limitations of its dependent claims 13 and 14.

Independent claim 11 has been further amended to recite a limitation similar to that incorporated into amended claim 5.

In view of the incorporation of its limitations into parent claim 11, dependent claim 13 has been amended to recite a limitation similar to that incorporated into amended claims 6 and 7.

Dependent claims 3 and 14 have been canceled in view of the incorporation of their limitations into their parent claims 1 and 11, respectively.

Applicant believes that the above amendments do not present new matter. Favorable reconsideration and allowance of remaining claims 1, 2, 4-13, and 15-20 are respectfully requested in view of the above amendments and the following remarks.

### **Double Patenting Rejection**

The Examiner rejected claims 1, 2, and 5-20 under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims in U.S. Patent No. 6,416,519 to VanDusseldorp. Applicant hereby acknowledges that the present application and VanDusseldorp are commonly assigned.

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In response, Applicant has amended independent claim 1 to incorporate the limitations of its dependent claim 3, which was not rejected for double patenting and recited the following limitation:

the legs have adjacent distal ends that are connected together so that the legs define a basket in the deployed position and the basket collapses as the legs are retracted into the sheath by the actuating means so as to define a grasping position in which the legs are operable to perform a grasping operation.

This same limitation is found in independent claim 11 as filed. Therefore, Applicant believes that the double patenting rejection inadvertently included claim 11 and its dependent claims 12-20, since the claims of VanDusseldorp do not recite or suggest connecting the distal ends of the legs.

In view of the above, Applicant respectfully requests withdrawal of the obviousness-type double patenting rejection.

#### **Rejection under 35 USC §102**

Independent claims 1 and 11 and their dependent claims were rejected under 35 USC §102 as being anticipated by U.S. Patent No. 6,183,482 to Bates et al. (Bates). Applicant respectfully requests reconsideration of this rejection in view of the amendments presented above as well as the following comments.

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Applicant's amended independent claim 1 recites a surgical device  
requiring:

the legs are capable of being retracted into the sheath  
with the actuating means to define a stowed position in  
which the legs are substantially parallel to each other and  
define a tubular shape having a circular opening defined by  
the first surfaces of the legs and a circular exterior cross-  
section defined by the second surfaces of the legs; . . .

Applicant's amended dependent claims 5, 6, and 7, which depend from claim  
1, require respectively:

each of the first and second surfaces of the legs has a  
constant radius of curvature, and the thickness of each of  
the legs in the directions of radials of the curvatures is  
substantially constant.

the transverse cross-sectional shape of each leg is further  
defined by lateral surfaces oppositely disposed from each  
other, at least a portion of each of the lateral surfaces being  
flat and lying in one of the radials of the curvatures of the  
first and second surfaces.

the transverse cross-sectional shape of each leg is further  
defined by lateral surfaces oppositely disposed from each  
other, at least a portion of each of the lateral surfaces being  
flat and lying in a radial of at least one of the first and  
second surfaces.

Applicant's amended independent claim 11 recites a surgical device requiring:

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... each of the legs comprising:  
a transverse cross-sectional shape defined by a concave surface, a convex surface oppositely disposed from the concave surface, and lateral surfaces oppositely disposed from each other, each of the concave and convex surfaces having a constant radius of curvature, and the thickness of each of the legs in the directions of radials of the curvatures being substantially constant; and  
... wherein when retracted into the sheath the legs are substantially parallel to each other and define a tubular shape having a circular exterior cross-section defined by the convex surfaces of the legs and a circular opening defined by the concave surfaces of the legs.

Applicant's amended dependent claim 13, which depends from claim 11, requires:

at least a portion of each of the lateral surfaces is flat and lies in the radials of the curvatures of the concave and convex surfaces.

Though Bates discloses a surgical device with legs that when stowed are parallel and each leg has a cross-sectional shape with, for example, oppositely-disposed concave and convex surfaces (Figure 8E) or oppositely-disposed flat radial surfaces (Figure 8B), Bates does not disclose a device whose legs (using the language of claim 1) "define a tubular shape having a circular opening defined by the first surfaces of the legs." Though the Examiner stated that "[r]eplacing the flat inside surface of the legs in Figure 6A with the

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concave surfaces of Figure 8E (column 5, lines 42,45), a circular opening is defined between the legs in the stowed position," Bates' Figure 8E indicates otherwise. Applicant has used Bates' Figures 8B and 8E to create end views of four-legged devices, as seen in an attachment to this Amendment. From the attachment, it is evident that Bates' does not disclose a device with "a circular opening," but instead at best discloses an opening with four distinct lobes (based on Figure 8E). The points of each crescent-shaped leg in Figure 8E project into Bates' opening to arguably "enhance the capturing and holding ability of the basket," which is "the second of the two goals" required by Bates (column 5, lines 45-49). These points would also probably have "improved cutting ability," which is said to be one of the "[a]dvantages [of] all other shapes according to the invention" (column 2, lines 10-15). However, Applicant believes it is not apparent how modifying Bates lobed opening to make it "circular" would accomplish either of these requirements.

In view of the above, Applicant believes that Bates does not disclose or suggest the "circular opening" required by independent claims 1 and 11.

Applicant also believes that Bates does not disclose or suggest other claim limitations, such as legs with constant thickness in the radial direction (claims 5 and 11) and flat radial surfaces between outer convex and inner concave surfaces (claims 6, 7, and 13).

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In view of the above, Applicant believes that Bates does not anticipate independent claims 1 or 11 nor any of their remaining dependent claims.

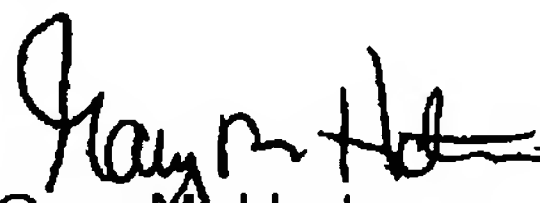
Applicant therefore respectfully requests withdrawal of the rejection under 35 USC §102.

**Closing**

In view of the above, Applicant believes that the rejections to his claims have been overcome, and that the claims define patentable novelty over all the references, alone or in combination, of record. It is therefore respectfully requested that this patent application be given favorable reconsideration.

Should the Examiner have any questions with respect to any matter now of record, Applicant's representative may be reached at (219) 462-4999.

Respectfully submitted,

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Attachments: Petition for Extension of Time; Figures 8B and 8E of Bates et al.